

REMARKS

This responds to the Office Action mailed on June 7, 2004.

Claims 14-20 are canceled. No claims are added or amended. As a result, claims 1-13 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claims will be presented in the same order in which the Examiner presented them in the Office Action.

Affirmation of Election

The Examiner required restriction to one of the following:

Group I: Claims 1-13

Group II: Claims 14-20

Group I (claims 1-13) was provisionally elected by Applicant's representative, Walter W. Nielsen, during a telephone conversation with Examiner Chukwurah on May 14, 2004. In addition, Applicant elected to prosecute Group I, claims 1-13, in a "Response to Restriction Requirement" filed in the U. S. Patent & Trademark Office on May 24, 2004.

The non-elected claims, claims 14-20, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions directed to the subject matter of the non-elected claims.

Amendment of the Title

The title has been amended to more accurately reflect the claimed subject matter by substituting "Systems" for "Tools, Systems, and Methods of Use".

Rejection of Claims 1-3 under 35 U.S.C. §102(b) as Anticipated by Glaser

Claims 1-3 were rejected under 35 U.S.C. §102(b) as being anticipated by Glaser et al. (U.S. 3,393,755).

Glaser discloses an engraving apparatus (FIG. 1) having a hand-manipulable engraving tool 12, a source of vacuum in the form of suction manifold 50, a source of air pressure in the

form of discharge line 26, and a supply hose 48 connected to engraving tool 12. As a rotor 92 inside rotary valve 72 rotates, the supply hose 48 to tool 12 is alternately pressurized and evacuated, and the operative end 32 of the engraving tool 12 is repetitively driven in the surface being engraved (see col. 3, line 66 through col. 4, line 31). It should be noted that Glaser fails to disclose a pilot hose to couple to the tool.

The rule under 35 U.S.C. §102 is well settled that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Regarding independent claim 1, the Examiner asserts that Applicant’s pilot hose reads on Glaser’s vacuum hose 52 and/or pressure pipe 80. However, this reading fails for several reasons.

First, as pointed out above, Glaser fails to disclose a tool control system wherein a pilot hose is to couple to the tool, in addition to a supply hose being coupled to the tool. Glaser doesn’t show a pilot hose to couple to the tool. In Glaser, only one hose 48 is coupled to tool 12.

Second, Glaser fails to disclose the limitation in claim 1 that “the control mechanism is to provide vacuum to the supply hose when air within the pilot hose has greater than a predetermined pressure, and wherein the control mechanism is to provide air pressure to the supply hose when air within the pilot hose has less than the predetermined pressure”, because in Glaser the hose 48 to tool 12 is alternately pressurized and evacuated, regardless of the pressure within hose 52 or within pipe 80 relative to a predetermined pressure.

For the above reasons, claim 1 should be found to be allowable over Glaser, and Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102(b) as anticipated by Glaser be withdrawn.

Claims 2-3, which depend from claim 1 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

**Rejection of Claims 4-13 under 35 U.S.C. §103(a) as Unpatentable
over Glaser in view of Obergfell**

Claims 4-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Glaser in view of Obergfell (U.S. 3,850,359).

Glaser was discussed earlier.

Obergfell discloses a stud gun or tool 20 (FIG. 1) operable on a combustible gas. Stud tool comprises two user-operable elements: a trigger 144 (FIG. 1; see col. 11, lines 4-6) and an operator member 120 (FIG. 1), which is successively moved by the operator through at least three positions, as illustrated in FIGS. 4-6, respectively, to prepare the stud gun for firing.

Regarding independent claims 4 and 9, the Examiner asserts that Obergfell's nosepiece 34 (FIG. 1) constitutes one of Applicant's "actuation elements". However, Obergfell's nosepiece 34, as described in col. 3, lines 11-16, appears to be a fixed structure into which a stud 36 is inserted. The nosepiece 34 may be placed against the workpiece, but it performs no actuation function.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Glaser in view of Obergfell fails to teach or suggest all of the claim limitations present in independent claims 4 and 9, so a *prima facie* case of obviousness has not been established.

For the above reasons, independent claims 4 and 9 should be found to be allowable over any combination of Glaser and Obergfell, and Applicant respectfully requests that the rejection of claims 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over Glaser in view of Obergfell should be withdrawn.

Claims 5-8 and 10-13, which depend from claims 4 and 9, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 1-13 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Documents Cited But Not Relied Upon For This Office Action

Applicant need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action, because these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

Conclusion

Applicant respectfully submits that claims 1-13 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date Nov. 8, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 8th day of November, 2004.

Chris Hammond

Name

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Signature